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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,087	09/16/2003	Sam Zellner	60027.0365US11/BLS97026	1675

7590 04/30/2007
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EXAMINER

PHAN, MAN U

ART UNIT	PAPER NUMBER
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2616

MAIL DATE	DELIVERY MODE
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04/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

CSK

Office Action Summary	Application No. 10/663,087	Applicant(s) ZELLNER, SAM	
	Examiner Man Phan	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :5/11/05, 11/26/04, 9/22/04, 8/18/04, 3/4/04, 2/19/04.

DETAILED ACTION

1. The application of Zellner for a "Associated systems and methods for providing data services using idle cell resources" filed 09/16/2003 has been examined. This application is a CIP of 09/922,042 filed 08/03/2001 is now U.S. Patent #7,065,061 which is a continuation of 09/579,000 filed 05/25/2000 is now abandoned which is a continuation of 08/903,534 filed 07/30/1997 is now US Patent# 6,069,882. Claims 1-30 are pending in the application.

Specification

2. Related Applications need to be updated.

The disclosure is objected to because of the following informalities: Under cross references to related applications, page 1 - lines 10-17, the continuation application status needs to be updated. Furthermore, application S/N 09/922,042 filed 08/03/2001 is now US Patent# 7,065,061.

Appropriate correction is required.

Claim Objections

3. Claims 17, 19, 20, 23, 24, 26-29 are objected to because of the following informalities:

The claims contain the phrase "adapted to". It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Appropriate correction is required.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in

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the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain : patent therefor ..." (Emphasis added). Thus, the term "same invention" in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 196%).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37CFR 3.7309.

6. Claims 1-15 of the present application Serial No. 10/663,087 (hereinafter Application '087) rejected under the judicially created doctrine of obviousness-type double patenting as

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being unpatentable over claims 1-42 of U.S. Patent No. 7,050,445 (hereinafter '445) and 6,069,882 (hereinafter '882) since the claim, if allowed, would improperly extend the "right to exclude" already granted in the patent:

The claims are identical and they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent, since the patent and the application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are equivalent in scope and embodiment. The language of the two claims is substantially identical and is equivalent in functioning. All of the structural elements of the patent claims are present in the pending claims, defined with either identical or equivalent language. Additionally, the functional language, scope and embodiment reflect identical operation, purpose, application, and environment.

With respect to the specific limitations, claims 1-42 of patent '445 and claims 1-28 of patent '882 are equivalent to the pending claims 1-15 of Application '087 for dynamic allocation of limited capacity by managing network resources in a communications system having a packet switch and a network access node. The pending claims 1-15 of Application '087 are equivalent to the combination of claims 1-42 of patent '445 and 1-28 of '882. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element

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whose function is not needed would be obvious to one skilled in the art.

7. Claims 16-30 of the present application Serial No. 10/663,087 (hereinafter Application '087) rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40-44 of U.S. Patent No. 7,065,061 (hereinafter patent '061) since the claim, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The claims are identical and they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent, since the patent and the application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are equivalent in scope and embodiment. The language of the two claims is substantially identical and is equivalent in functioning. All of the structural elements of the patent claims are present in the pending claims, defined with either identical or equivalent language. Additionally, the functional language, scope and embodiment reflect identical operation, purpose, application, and environment.

With respect to the specific limitations, claims 40-44 of patent '061 are equivalent to the pending claims 16-30 of Application '087 for transmitting data using idle communications system resources. The pending claims 16-30 of Application '087 are equivalent to the combination of claims 40-44 of patent '061. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. It has been held that the

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omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Solondz (US#6,192,248) is cited to show the Service customization in a wireless communication system.

The Solondz (US#5,615,249) is cited to show the Service prioritization in a cellular telephone system.

The Chuah (US#6,226,277) is cited to show the Method for admitting new connections based on usage priorities in a multiple access system for communications networks.

The Chuah (US#6,377,548) is cited to show the Method for admitting new connections based on measured quantities in a multiple access system for communications networks.

The Chuah (US#6,567,416) is cited to show the Method for access control in a multiple access system for communications network.

The Ueda (US#6,009,331) is cited to show the Communication system having means for enabling channel assignment to calling terminal according to prior.

The Dalal (US#6,321,093) is cited to show the System and method for controlling priority calls in a wireless network.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Phan whose telephone number is (571) 272-3149. The examiner can normally be reached on Mon - Fri from 6:00 to 3:00.

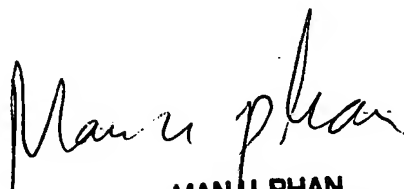
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (571) 272-3134. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.

Mphan

04/26/2007



MANU. PHAN
PRIMARY EXAMINER